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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,178	09/10/2001	Christopher J Fenton	36-1486	9548

23117 7590 08/26/2004

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EXAMINER

HOOSAIN, ALLAN

ART UNIT	PAPER NUMBER
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2645

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DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/936,178

Applicant(s)

FENTON ET AL.

Examiner

Allan Hoosain

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-18 and 20 is/are rejected.
- 7) ☒ Claim(s) 9 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Allowable Subject Matter

1. Claims 9,19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Drawings

2. The drawings, Figures 1-3 and 5-7 are objected to under 37 CFR 1.83(a) because they fail to show a legend describing the numbers as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-8,10-18,20 are rejected under 35 U.S.C. 102(e) as being anticipated by **Houde et al.** (US 5,978,678).

As to Claims 1,11, with respect to Figures 1-3, **Houde** teaches a method of providing a user of a home network, 12, with use of a visited fixed network, 32, the method comprising

registering the user with the visited fixed-network, 32, including supplying a visitor node which is located in the visited fixed network with the IMSI (identity of a user-selected fixed termination) and

with a first identification number, MIN, the first identification number identifying the user and a home node which is located in the home network, 12, and

registering the visitor node as a proxy with the home node so as to allow routing by the home node of a call intended for the user to the user-selected fixed termination (Col. 4, lines 32-67).

As to Claims 2,12, with respect to Figures 1-3, **Houde** teaches a method of configuring a home network, 12, to provide a user, 16, of the home network, who is assigned a TMSI (user number), use of a visited fixed network, 32,the method comprising

receiving the identity of a visitor node located in the visited fixed network (Col. 4, lines 39-52),

storing and associating the identity of the visitor node with the user number and receiving billing data from the visitor node for charging the user (Col. 4, lines 52-60 and Col. 1, lines 33-44).

As to Claims 3,13, with respect to Figures 1-3, **Houde** teaches a method of configuring a visitor node, 34, to provide a user, 16, of a home network, 12, with use of a visited fixed network, 32, in which the visited node is located, the method comprising

receiving MIN (an identification number) for identifying the user and identifying a home node which is located in the home network,

requesting and receiving confirmation of registration with the home node and sending to the home node billing data arising from the user's use of the visited fixed network (Col. 4, lines 52-60 and Col. 1, lines 33-44).

As to Claims 4,14, **Houde** teaches a method according to claim 1 wherein the visitor node comprises a visitor switching means and a visitor location database (Figure 1, labels 34,42).

As to Claims 5,16, **Houde** teaches a method according to claim 1 wherein the user-selected fixed termination is assigned a temporary routing number (Col. 5, lines 28-31).

As to Claims 6,17, **Houde** teaches a method according to claim 1 further providing a further user of the home network with use of the visited fixed network, wherein a call intended for the further user is routed to the user-selected fixed termination (Col. 5, lines 1-10).

As to Claims 7,15, **Houde** teaches a method according to claim 1 wherein the visited fixed network is a public switched telephone network and including supplying a visitor node with the identity of a user-selected fixed

Art Unit: 2645

termination comprising providing the telephone number of a terminal attached to the visited fixed network (Col. 6, lines 5-12).

As to Claims 8,18, **Houde** teaches a method according to claim 1 further comprising supplying the user with a temporary directory number (second identification number) for enabling the user to use the visited fixed network and for enabling the visitor node to record the use of the visited fixed network by the user (Col. 6, lines 24-29).

As to Claims 10,20, **Houde** teaches a method according to either claim 8 wherein the recorded use of the visited fixed network is supplied to the home node for the purposes of billing (Col. 1, lines 32-44).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kennedy et al. (US 5,799,249) teach setting up calls using different cellular networks through a platform.

Emery et al. (US 5,758,281) teach making outgoing calls by subscribers from a visiting network.

6. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231
or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Art Unit: 2645

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Allan Hoosain

Allan Hoosain

Primary Examiner

8/16/04